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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 10/526,796 | 01/10/2006 | Ko Kaku | HO-P03144USO | 7396 |
| 26271 | 7590 | 09/17/2009 | | |
| FULBRIGHT & JAWORSKI, LLP | | | EXAMINER | |
| 1301 MCKINNEY | | | BEKKER, KELLY JO | |
| SUITE 5100 | | | | |
| HOUSTON, TX 77010-3095 | | | ART UNIT | |
| | | | PAPER NUMBER | |
| | | | 1794 | |
| | | | NOTIFICATION DATE | |
| | | | DELIVERY MODE | |
| | | | 09/17/2009 | |
| | | | ELECTRONIC | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/526,796

Applicant(s)

KAKU ET AL.

Examiner

KELLY BEKKER

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7, 11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7, 11 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Amendments made 7/16/09 have been entered.
Claims 2-7, 11, and 13-15 remain pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 16, 2009 has been entered.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-7, 11, and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites, "A coffee brewing capsule obtainable by a process comprising the steps of... crushing the compressed body of coffee in the sachet to form a particulate coffee product for placement in a brewing capsule". It is unclear as to if the sachet is the brewing capsule claimed by the preamble or if the claim does not recite an active step for forming the instantly claimed brewing capsule.

If the sachet is the brewing capsule, the claim appears to contradict itself as the claim recites that the compressed coffee body is crushed in the sachet, yet the claim also recites that the coffee body is not ready to be placed in the brewing capsule until crushed. Furthermore, it is unclear as to how the particulate coffee product is ready for placement into a brewing capsule when it is already in a brewing capsule (i.e. the sachet); it is unclear as to; it is unclear as to if the sachet is somehow formed into a brewing capsule, or if the claim has some other meaning.

If the sachet is not the brewing capsule, the claim is incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: placement of the particulate coffee from the sachet into a brewing capsule. The claim is directed towards a brewing capsule and recites a particulate coffee that is ready for placement into a brewing capsule, but never recites the active step of forming a brewing capsule.

Claims 2-7, 11, 13, and 14 are included in the rejection due to their dependency on claim 15.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-7, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al (US 5853788) in view of Perry et al (ed.) (Perry's Chemical Engineers' Handbook 7th Edition pages 20-82 through 20-84).

Murphy et al (Murphy) a process for the preparation of a coffee product comprising the steps of grinding a roasted coffee (column 5 lines 58-63), externally cooling the coffee prior to or during compressing (column 7 lines 40-48), compressing the coffee in a pellet mill with a roller to form a compressed body of coffee (column 6 all), crushing the compressed coffee to form a particulate product (column 9 lines 14-17), and packaging the particulate coffee (column 8 lines 28-32). Murphy teaches that the coffee product is brewed (column 9 lines 35 and 36). Murphy teaches that the press is a roller press as defined by applicant (applicant's specification page 2 lines 18-20) by teachings that apparatus compacts particulate materials into shaped products by compression against at least one roller (Murphy column 6 all). Murphy teaches that the tap density, i.e. the density of the agglomerated product, of the ground compressed tablet is 0.5-0.7gm/cc (column 7 lines 58-60). Regarding the particulate size of the coffee as recited in claim 13, as Murphy teaches that the volumetric particle size of the particulate coffee is from 270-1100um and the median volumetric size of the particulate

is from 270-1100um (abstract), one of ordinary skill in the art would expect that the volume mean diameter also be within the range of 270-1100um. Regarding the density of the compressed coffee as recited in claim 7, since Murphy teaches of substantially the same processes of producing the pressed coffee as instantly claimed and since Murphy teaches that the compressed coffee crushed has substantially the same particle size as the instantly claimed crushed compressed coffee, one of ordinary skill in the art at the time the invention was made would expect that the compressed coffee taught by Murphy inherently have the same properties, including density, as instantly claimed. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the density of the compressed coffee when it was desired to keep the compressed pellet the same size, but to vary the concentration of coffee desired in each of the compressed pieces. One would have been motivated for the compressed coffee to remain the same size so that the same forming equipment would be acceptable; One would have been motivated to increase the density in order to form a lighter intensity coffee tablet, alternatively, one would have been motivated to decrease the density in order to form a more intense coffee tablet. To vary the density of the coffee tablet would be common sense and routine determination.

Murphy is silent to the roller press as comprising a pocketed roller as recited in claim 15, preferably two pocketed rollers as recited in claim 6, to the roller press as comprising a profiled roller as recited in claim 5, to the coffee as in a brewing capsule as recited in claim 15, to the compressed coffee as placed in a sachet, sealing the sachets edges, and then crushing the coffee in the sachet as recited in claim 15, and to the compressed tablets as not having opposed flat faces as recited in claim 11.

Perry et al (Perry) teaches that the roller press and pellet mill are both used to compress particulate materials together and form pellets (page 20-82 and 20-83). Perry teaches that the roller press can produce large quantities of materials at a low cost (page 20-82). Perry teaches that the roller press had two rollers with pockets or indentations in the roller surface (page 20-82). Perry teaches that the pockets and/or indentations form the shape of the pellets (page 20-82).

Regarding using a roller press with at least one, preferably two rollers with profiled or pocketed surfaces as forming the compressed coffee tablets, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a roller press comprising two rollers as the pellet mill as taught by Murphy in order to process large quantities of material at a low cost as taught by Perry. As Perry teaches that the pockets and/or indentations form the shape of the pellets, it would have been further obvious to one of ordinary skill in the art at the time the invention was made to use profiled or pocketed rollers or a combination of both depending on the shape and texture of the final product desired. For example, one would have been motivated to use two pocketed rollers to form a smoothly rounded final product; one would have been motivated to use a profiled roller to form a more textured final product; one would have been motivated to use a combination of a pocket and profiled roller to form a final product which was both smooth and textured.

Regarding the coffee as in a brewing capsule, as stated above it is unclear as to if the brewing capsule is the sachet or another package. Regardless, it is believed the claimed limitations are met. It would have been obvious to one of ordinary skill in the art for the packaged coffee product for brewing as taught by Murphy to be packaged in a brewing capsule sachet, so that the product could be easily brewed from the package. Murphy teaches that brewing capsule sachets (i.e. porous tea bag structures) were known and used in the art (Column 3 lines 9-12) and the use of a conventional package, such as a brewing capsule sachet, for its intended function would have been obvious and within the routine determination of one of ordinary skill in the art.

Regarding the compressed coffee as placed in a sachet, sealing the sachets edges, and then crushing the coffee in the sachet, as stated above the claim language is unclear. Regardless, it is believed that the claimed limitations are met.

If the sachet is the brewing capsule, as stated above it would have been obvious to one of ordinary skill in the art to package the coffee product as taught by Murphy in a brewing capsule sachet. One would have been further motivated for the coffee to be enclosed in the brewing capsule sachet during crushing so that the crushed particulates would not disperse everywhere thus allowing for increased product recovery (the

particulates would remain in the sachet and would not disperse into the atmosphere during compression) and easier clean up (all of the particulates would remain in the sachet and not on the compression equipment). To enclose a compressed body to be crushed in a sachet would be common sense and routine determination of one of ordinary skill in the art. Furthermore, one of ordinary skill in the art would not expect packaging the coffee in the brewing capsule sachet, including placement into the package and sealing the package, before crushing of the compressed coffee or packaging the coffee in the brewing capsule sachet, including placement into the package and sealing the package, after crushing of the compressed coffee to make a patentable distinction in the instantly claimed product; Regardless of the order, both methods crush the compressed coffee and package the coffee in a brewing capsule sachet and the final product remains a crushed compressed coffee in a brewing capsule sachet. Applicant is reminded that to switch the order of performing process steps would be obvious absent any clear and convincing evidence and/or arguments to the contrary (MPEP 2144.04 [R-1]). "Selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results" and "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted); When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

If the sachet is not the brewing capsule, and the compressed coffee is placed in a sachet, crushed, and then placed in a brewing capsule, as stated above, it would have been obvious to one of ordinary skill in the art to package the coffee product as taught by Murphy in a brewing capsule sachet. One would have been further motivated for the

coffee to be placed within the brewing capsule sachet as a final product so that the package was not damaged during crushing. One would have been further motivated for the coffee to be enclosed in a readily available conventional package, such as a sachet, during crushing so that the crushed particulates would not disperse everywhere thus allowing for increased product recovery (the particulates would remain in the sachet and would not disperse into the atmosphere during compression) and easier clean up (as all of the particulates would remain in the sachet and not on the compression equipment). To enclose a compressed body to be crushed in a sachet would be common sense and routine determination of one of ordinary skill in the art. Furthermore, regardless of if the product is crushed in a sachet or not, as the product of Murphy remains a crushed compressed coffee in a brewing capsule sachet the product appears to be the same as the instantly claimed invention. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted); When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

Regarding the compressed tablets as not having opposed flat faces, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the roller pockets to be in a rounded shape so that the pellets could be easily removed and pieces of the coffee would not get stuck in the corners of the pocket, thus forming compressed tablets with rounded corners, i.e. compressed tablets not having opposed flat faces. To do so would be common sense and within the routine determination of one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed July 16, 2009 regarding the prior art rejections have been fully considered but they are not persuasive.

Applicant argues that the references of record do not teach the newly added limitation of the compressed coffee as placed in a sachet, sealing the sachets edges, and then crushing the coffee in the sachet as recited in claim 15. Applicant's argument is not convincing. The newly added limitation has been addressed in the rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY BEKKER whose telephone number is (571)272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Bekker/
Examiner
Art Unit 1794